REMARKS

Amendment to the Claims

The claims have been amended in accordance with the examiner's comments in her rejection under 35 U.S.C. 112, second paragraph.

Obviousness-type double patenting rejections

(1) This application is a divisional application and represents a narrower embodiment of the invention described in U.S. Patent 6,380,246 and as such a terminal disclaimer has been filed which should overcome this rejection.

(2) The claims of the application have been rejected under obviousness-type double patenting over U.S. Patent 5,262,383 and U.S. Patent 5,945,444 (both Fischer et al.). However, as indicated during prosecution of the '246 patent, this is a selection invention wherein the specific substitution pattern on the phenyl group confers unexpected results which is not taught or disclosed by the '383 or '444 patents.

Both Fischer et al. patents are primarily directed toward a 2,4-substitution pattern on the phenyl group whereas the applicants' claims are not only directed to a 2,4,6-substitution pattern but is also fairly specific as to the nature of the substituents that can be on the phenyl group.

A copy of the declaration by Christopher Erdelen from the parent application is re-submitted for consideration by the examiner. Although the comparative examples utilize compounds wherein Het = a furan rather than Het = a thiophene as in the present claims, claims 1 and 2 of the '246 patent are inclusive of both types of Het rings.

The Erdelen declaration shows numerous examples of 2,4,6 substitution like that of the present claims which show superior activity against plant damaging insects and mites as compared to their 2,4-substituted counterparts (i.e. compounds represented by Fischer et al.).

Moreover, even if one were to argue that Fischer et al. directed one of ordinary skill in the art to a 2,4,6-substitution pattern, the argument would strain to accommodate the specifics of the

applicants' 2,4,6-substitution pattern was clearly taught by Fischer et al., i.e. the substitution pattern of the present invention requires that at least one halogen is in the ortho position (i.e. position 2 or 6) and requires that there is an alkyl group at either the 4- or 6-position.

As further evidence of the criticality of the specific 2,4,6 substitution pattern, the applicants present a declaration by Mr. Ulrich Kniehase which compares the effect of a 2,4,6-trimethyl substituted compound (which was specifically claimed in the 5,945,244 patent - see col. 92, third compound down - and is "encompassed" by the 5,262,383 patent) vs. a compound of the applicants' claimed invention, i.e. a 2,4-dichloro-6-methyl substituted compound. As can be seen from the comparative data, the compound of the applicants' invention unexpectedly shows complete mortality against Plutella whereas the compound of the prior art only showed partial mortality.

Therefore, for any of the above reasons, it is believed that the applicants' claims are unobvious over the prior art.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Services as Express Mail Label No. EV383033696 US in an envelope addressed to: Assistant Commissioner for Patents,P.O.Box 1450, Alexandria, VA 22313-1450 on February 5, 2004.

NORRIS, McLAUGHLIN & MARCUS, P.A.

By Agata Glinska

Date Agata Glinska